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27776	7590	08/05/2008	EXAMINER	
WARD & OLIVO SUITE 300 382 SPRINGFIELD AVENUE SUMMIT, NJ 07901			LASTRA, DANIEL	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/759,103

**Applicant(s)**

CLARK ET AL.

**Examiner**

DANIEL LASTRA

**Art Unit**

3688

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-16 and 18-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-16 and 18-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-11, 13-16 and 18-36 have been examined. Application 09/759,103 (SEARCH ENGINE PROVIDING AN OPTION TO WIN THE ITEM SOUGHT) has a filing date 01/12/2001.

### **Response to Amendment**

2. In response to Final Rejection filed 05/21/2007, the Applicant filed an RCE on 05/08/2008, which amended claims 1, 3, 6, 10, 11, 15, 16, 21, 22, 23, 28, 31-36 and cancel claims 12 and 17.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 10, 15, 21, 22, 35 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims recite "*generating an outcome indicator independent of and differently distributed from the trial outcome; displaying the outcome indicator to the user*". Said limitation is indefinite because it is not clear the linkage between an outcome indicator and a trial outcome. Are same terms related? For purpose of art rejection, said limitation would be interpreted as meaning generating two different outcomes, a trial outcome and an outcome indicator.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6-11, 13-16, 18-26, 27, 28, 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 2003/0054888) in view of bottomdollar.com (<http://www.web.archive.org/web/19991013040730/http://bottomdollar.com/index.html>) and further in view of Walker (US 6,364,765).

As per claims 10 and 20-22, Walker (888) teaches:

A method of providing a user with a game of chance, the method comprising:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing at a least one product, a price of the product and a third-party retail vendor of the product (see Walker paragraphs 38 and 39).

automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment (see Walker paragraph 130), or requesting the first option and a second option to purchase the product (see Walker paragraphs 34; 149);

if the user chooses to play the game:

electronically calculating a dynamic probability of winning the product by the user *based on one more factors selected from a group consisting of: the cost of the selected*

*product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the, user's behavior during a user session (see Walker paragraphs 89, 94, 98, 110). Walker's probability of winning is dynamic because it varies according to the rating of a customer (see paragraph 89), the revenue generated (see paragraph 94) or customer's behavior (see paragraph 124).*

*electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning (see Walker paragraph 144);*

*in response to a winning trial outcome, purchasing the product for the user (see Walker paragraph 145) from the third-party retail vendor (see Walker paragraph 39) at no cost to the user (see paragraph 130);*  
and

*if the user chooses to purchase the product instead of playing the game:*

*directing the user to a web site which sells the product (see Walker paragraph 34,149-151);*

Walker does not expressly teach retrieving at least one product information from at least one database storing *independent* third-party retail vendor product information. However, bottomdollar.com teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest and receive back a comparative list of independent third party retail vendors of said item giving users the option to buy said item from a selected

vendor in said list (see bottomdollar.com pages 1 and 2). Walker also teaches in figure 6, third party manufacturers of products (see “campbell’s, Volvo, sony”). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would display to users a list of different independent third-party providers vendors of users’ selected products, as taught by bottomdollar.com, where said users would have the opportunity to play a game to win said products in order to enable said users the purchase of products from competing product providers, therefore obtaining the best price, with the added incentive of allowing said users to even play a game in order to obtain said products for free (see Walker paragraphs 125, 130).

Walker does not teach and *generating an outcome indicator independent of and differently distributed from the trial outcome; displaying the outcome indicator to the user*. However, Walker (765) teaches that it is old and well known in the gaming art to play different games of chance in a game machine and obtain different outcomes from said playing (see col 2, lines 25-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker (888) would allow customer to play different games of chance, as taught by Walker (765) in order to give customer a higher probability of winning a product.

As per claim 1, Walker (888) teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals from a user system representing search parameters descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing the retrieved product information and associated prices (see Walker figure 6).

automatically providing the user an option to play a game to win a selected product from said product information without the user first making any payment (see paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a *dynamic* probability of winning the selected product by the user *based on one more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the, user's behavior during a user session* (see Walker paragraphs 89, 94, 98, 110). Walker's probability of winning is dynamic because it varies according to the rating of a customer (see paragraph 89), the revenue generated (see paragraph 94) or customer's behavior (see paragraph 124);

electronically generating *a trial outcome, the probability of the trial outcome generating a winning trial outcome* corresponding to the calculated probability of winning (see Walker paragraph 144);

in response to a winning trial outcome, purchasing the product for the user (see Walker paragraph 145) from the third-party retail vendor (see Walker paragraph 39) *at no cost to the user* (see paragraph 130);

Walker does not expressly teach retrieving at least one product information from at least one database storing *independent* third-party retail vendor product information a and *generating an outcome indicator independent of and differently distributed from the trial outcome; displaying the outcome indicator to the user*. However, the same argument made in claim 10 regarding this missing limitation is also made in claim 1

As per claim 15, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals from a user system representing at least one search parameter descriptive of a product (see Walker paragraph 39);

transmitting electronic signals to the user system representing a plurality of different third-party retail vendors and associated prices charged by each of said different third-party retail vendors for products identified in response to said at least one search parameter (see Walker figure 6).

automatically transmitting electronic signals to the user system representing an option to play a game to win a selected product or service without the user first making any payment (see Walker paragraph 130) or requesting the option (see Walker paragraph 34; 149);

electronically calculating a *dynamic* probability of winning said selected one product by the user *based on one more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds*



*received and the user's behavior during a user session (see Walker paragraphs 89, 94, 98, 110). Walker's probability of winning is dynamic because it varies according to the rating of a customer (see paragraph 89), the revenue generated (see paragraph 94) or customer's behavior (see paragraph 124);*

*electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning (see Walker paragraph 144);*

*in response to a winning trial outcome, purchasing the product for the user (see Walker paragraph 145) from the third-party retail vendor (see Walker paragraph 39) at no cost to the user (see paragraph 130);*

*Walker does not expressly teach retrieving at least one product information from at least one database storing independent third-party retail vendor product information and generating an outcome indicator independent of and differently distributed from the trial outcome; displaying the outcome indicator to the user. However, the same argument made in claim 10 regarding this missing limitation is also made in claim 15.*

As per claims 6, 11, 16, 26, 28 Walker teaches:

*comprising providing the user with an opportunity to increase the chances of winning on successive plays of the game by performing a task for which a third party, such as a game provider, provides compensation to the provider of the game of chance (see paragraphs 124-125).*

As per claims 7, 12 , Walker teaches:

calculating a probability of winning based on at least a current budget (see Walker paragraph 144).

As per claims 8, 13 and 18, Walker teaches:

calculating a probability P of winning based on a total number of game players (see Walker paragraph 110).

As per claim 23, Walker teaches:

providing a user an opportunity to win a product or service of claim 22 further comprising the step of purchasing the selected product or service for the user *and at no cost to the user*, if the outcome for the play of the game is a win (see Walker paragraphs 129-131).

As per claim 25, the same rejection applied to claims 7-8 is also applied to claim 25.

As per claims 2, 24 and 27, Walker teaches:

wherein the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system (see Walker paragraphs 26 and 89).

As per claims 9, 14 and 19, Walker teaches:

calculating a probability P of winning based on:

$$P = \frac{P_a * P_t * P_m + P_u}{N}$$

where:

Walker does not expressly teach  $P_a$  is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available.

However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that as the value of a prize approaches the total budget of a game of chance system, the more difficult would be the probability of winning a grand prize (see Walker paragraph 143).

Pt is a probability factor that varies with a current prize budget (see Walker paragraph 118-119);

Pm is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received (see Walker paragraph 118-119);

Pu is probability factor that varies with the user's behavior during a user session (see Walker paragraph 88); and

N is a number of current users (see Walker paragraph 110).

As per claim 31, Walker fails to teach:

collecting a database of *independent* third party retail vendor product information prior to receiving the search parameters from the user. However, bottomdollar.com teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest and receive back a comparative list of independent third party retail vendors of said item giving users the option to buy said item from a selected vendor in said list (see bottomdollar.com pages 1 and 2). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would be motivated to display to users a list of different

independent third-party providers vendors of users' selected products, as taught by bottomdollar.com, where said users would have the opportunity to play a game to win said products in order to enable said users the purchase of products from competing product providers, therefore obtaining the best price, with the added incentive of allowing said users to even play a game in order to obtain said products for free (see Walker paragraphs 125, 130).

As per claim 32, Walker teaches:

transmitting electronic signal as representing product info and said automatically providing an option to play is by transmitting a webpage containing at least a link to a webpage of the third party retail vendor and a link to initiate playing to win the same product (see Walker paragraph 39). Walker does not expressly teach that said retail vendor is an independent retail vendor. However, the same rejection applied to claim 1 regarding this missing limitation is also applied to claim 32.

As per claim 33, Walker teaches:

A method for increasing user traffic to a search engine website, comprising:

transmitting a results webpage to the user system, the results page including at least one link for redirection to a third party vendor website where the user system can interact with at least one webpage to purchase a corresponding product and further including in the same webpage a play link corresponding to said third party vendor link for redirection to a webpage which allows the user to play a game of chance to win the product at no cost to the user corresponding to the third party website redirection link (see Walker paragraphs 39 and 132). Walker fails to teach receiving a search query

from a user system interacting with a search webpage of the website, the search query defining a desired product for the user and that said third party vendor website is an independent vendor website. However, bottomdollar.com teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query for an item that said users have an interest and receive back a comparative list of independent third party retail vendors of said item giving users the option to buy said item from a selected vendor in said list (see bottomdollar.com pages 1 and 2). Therefore, the same rejection applied to claim 1 regarding this missing limitation is also applied to claim 33.

As per claim 34, Walker does not expressly teach:

wherein said play link webpage is provided by the search engine website and wherein the search engine website calculates the outcome of the game of chance for a user system selecting to play to win the product and further wherein if the user outcome is favorable the search engine website facilitating the purchase of the product from the independent third party vendor corresponding to the third party website redirection link. However, bottomdollar.com teaches a search engine website which facilitates the purchase of a product from a independent third party vendor (see Roll paragraph 57). Therefore, the same rejection applied to claim 33 is also applied to claim 34.

As per claims 35 and 36, Walker teaches:

A method for increasing user traffic to a search website, comprising:

retrieving product information and corresponding price from said third party websites for at least one products satisfying said query (see Walker paragraphs 38-39);

providing a game of chance in response to a user selection of the link to win the product; and purchasing the product from the third party for the user response to a favorable outcome in said game; transmitting at least one results webpage to the user, the results webpage including at least one link for the product information, a corresponding price, a link to the third party website, and a link to win the product (see Walker paragraphs 38-40);

providing a game of chance in response to a user selection of the link to win the product (see Walker paragraph 40); and

purchasing the product from the third party for the user in response to a favorable outcome in said game (see Walker paragraph 41).

*wherein the probability of winning the product by the user is dynamically calculated based on one more factors selected from a group consisting of: the cost of the selected product in relation to the total cost of all products available, a current prize budget, a ratio of the current prize budget to a total amount of funds received and the, user's behavior during a user session (see Walker paragraphs 89, 94, 98, 110). Walker's probability of winning is dynamic because it varies according to the rating of a customer (see paragraph 89), the revenue generated (see paragraph 94) or customer's behavior (see paragraph 124);*

electronically generating a trial outcome, the probability of the trial outcome generating a winning trial outcome corresponding to the calculated probability of winning (see Walker paragraph 144);

in response to a winning trial outcome, purchasing the product for the user (see Walker paragraph 145) from the third-party retail vendor (see Walker paragraph 39) *at no cost to the user (see paragraph 130)*;

Walker fails to teach:

providing a search webpage containing a search interface for a user to submit a search query for a product; receiving a search query from a user employing said search webpage; searching *independent* third party websites by reference to said query and *generating an outcome indicator independent of and differently distributed from the trial outcome; displaying the outcome indicator to the user.* However, the same rejection applied to claim 33 regarding these missing limitations is also applied to claim 35.

5. Claims 3-5, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of bottomdollar.com (<http://www.web.archive.org/web/19991013040730/http://bottomdollar.com/index.html>) and further in view Walker (US 6,364,765) and Yoseloff (U.S. 6,331,143).

As per claims 3 and 29, Walker fails to teach:

wherein the *display comprises* a user chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. However, Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated random number (see Yoseloff column 8, lines 35-50;

column 7, lines 50-64; column 3, lines 35-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Walker and bottomdollar.com system would allow customers to play a game where the user would choose a number and the system would generate a random number, and where the customer would win a prize when the user-chosen number matches the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games, without losing anything if the customer does not receive a winning outcome.

As per claim 4, Walker does not teach:

wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number. Yoseloff teaches about the different probabilities associated with matching a one or more digits number chosen by a user with a random number generated by a system (see Yoseloff column 8, lines 6-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a user would use the Walker system would select a product and would play a game to have the opportunity to win the product and to win the game and the product the user would choose a number and the system would generate a random number where the winning outcome would be determined if at least one digit of the user-chosen number matches at least one digit of the system generated random number, as taught by Yoseloff. This feature would give customers an



incentive to visit the retailer site as customers would have the opportunity to win products by playing games without losing anything if the customer does not receive a winning outcome.

As per claim 5, Walker does not expressly mention:

wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number. However, Walker teaches that the probability of receiving a winning outcome varies with customers, where loyal customers would have a higher probability of receiving a winning outcome and winning the product than other customers that are not as loyal to the provider of the products (see Walker paragraph 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would vary the probability of receiving a winning outcome based upon the customers loyalty to the retailer and, therefore, the probability of winning the game would be different than one calculated with probabilistic method such as one divided by ten raised to the power of the number of digits in the comparison number. Walker would give a higher probability of winning the game to a loyal customer to thank him or her for being a loyal customer, which would serve as an incentive to continue visiting the shop.

As per claim 30, Walker teaches:

wherein the user can increase the probability of winning the product or service by participating in an online survey for an advertising sponsor (see paragraph 124).

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-11, 13-16 and 18-36 have been considered but are moot in view of the new ground(s) of rejection. The Applicant argues that the prior art does not teach "generating a trial outcome and an outcome indicator independent of, and differently distributed from the trial outcome before displaying the outcome indicator to the user". The Examiner answers that nowhere in Applicant's claimed limitation is recited "before displaying the outcome indicator to the user", therefore, the Applicant is arguing about limitation not stated in the claims.

The Applicant argues that Walker does not teach providing the product at no cost to the user. The Examiners that Walker teaches providing a product at no cost to the user (see paragraph 130). Therefore, contrary to Applicant's argument, Walker teaches Applicant's claimed limitation.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Art Unit: 3688

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/

Art Unit 3688

July 18, 2008